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David Goodman

Poly-32

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26479

7590

08/31/2006

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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,072

Applicant(s)

GOODMAN ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Status:

Claims 1-43 are pending. Claims 1-43 are rejected as detailed below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites “determining whether or not the storage medium has been assigned a unique volume label and a unique storage medium label.” The specification does not contain a description a clear and concise description of the manner of making and using “a unique storage medium label” such that one of ordinary skill in the art would be convinced that the inventor had possession of the claimed invention at the time of filing instant application. Particularly the specification does not describe how it is determined whether the storage medium has been assigned a unique storage medium label.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “determining whether or not the storage medium has been assigned a unique volume label and a unique storage medium label.” The scope of the invention cannot be determined because it is unclear what difference, if any exists between “a unique volume label” and “a unique storage medium label.” For purposes of this Office action, it will be assumed that above labels are one and the same thing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 10-15, 19-27, 29-35 and 39-42 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,483,602 issued to Haneda (hereafter Haneda), as best examiner is able to ascertain.

Claims 1 and 20:

Haneda discloses:

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a) determining whether or not the storage medium has been assigned a unique volume label and a unique label identifier [identification code is stored on the original film, on the user's recording medium and on the laboratory's recording medium, col 4, lines 8-15, col 19, lines 50-65, process of generating a label for a new disk which does not have a label, Fig 3]

b) if the storage medium has not been assigned a unique volume label and a unique label identifier, then

(i) determining a unique label identifier for the storage medium [identification code is stored on the original film, on the user's recording medium and on the laboratory's recording medium, col 4, lines 8-15],

(ii) determining a unique volume label for the storage medium [identification code is stored on the original film, on the user's recording medium and on the laboratory's recording medium, col 4, lines 8-15],

(iii) writing the unique volume label onto the storage medium [identification code is stored on the original film, on the user's recording medium and on the laboratory's recording medium, col 4, lines 8-15], and

(iv) providing a command to generate a label based on the unique label identifier, the label to be associated with the storage medium [identification code is stored on the original film, on the user's recording medium and on the laboratory's recording medium, col 4, lines 8-15]; and

c) updating a database based on files, if any, added to or deleted from the storage medium [col 7, lines 3-15]

Claims 2 and 21:

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Haneda discloses d) synchronizing the database with a database on a device apart from the read/write machine [Fig 2, 36]

Claim 3:

Haneda discloses the read/write machine is a personal computer [Fig 2, 30] and the device is a handheld device [paragraph 46]

Claim 4, 22 and 23 :

Haneda discloses wherein the device is an untethered handheld device [paragraph 14 – wireless]

Claim 5 and 24:

Haneda discloses wherein the read/write machine is a computer with at least one of (a) a floppy disk drive, (b) a CD ROMK drive, (c) a ZIP drive, and (d) a DVD drive [Fig 1, 16]

Claim 6 and 25:

Haneda discloses wherein the label based on the unique label identifier is a bar code label [Fig 12]

Claim 7 and 26:

Haneda discloses wherein the act of determining a unique volume label is based, at least in part, on state information accessible to the read/write machine [col 15, lines 1-50]

Claim 8 and 27:

Haneda discloses wherein the state information is a count sequence [frame identification number, col 5, lines 35-45]

Claims 10 and 29:

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Haneda discloses (d) accepting information read from a label associated with the storage medium without reading the storage medium, (e) converting the accepted information into a database key, (f) requesting records from a database instance using the database key (g) accepting records in response to the request and (h) rendering information about the accepted records [Fig 2, col 19, lines 7-20]

Claims 11 and 30:

Haneda discloses wherein the label associated with the storage medium is a bar code and wherein the information read from the label is accepted from a bar code scanner [Fig 2].

Claims 12 and 31:

Haneda discloses wherein the information about the accepted records rendered includes file names [Fig 14].

Claims 13 and 32:

Haneda discloses wherein the accepted information read from a label associated with the storage medium is read by a handheld device, and the information about the accepted records is rendered on the handheld device [paragraph 39]

Claim 14:

Haneda discloses wherein the read label is converted into a database key by the handheld device, the records are requested from a database instance using the database key by the handheld device, and the records are accepted in response to the request by the handheld device [Fig 2, col 19, lines 7-20]

Claims 15 and 35:

Haneda discloses:

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- (a) accepting one or more search parameters [user requests extra prints from laboratory, col 4, lines 5-15, user retrieves according to frame numbers of the film, col 3, lines 55-60] selected from a group of parameters consisting of (A) file name, (B) file size, (C) file author and (D) file type [col 54, lines 35-40]
- (b) generating a query based on the search parameters [user requests extra prints from laboratory, col 4, lines 5-15]
- (c) accepting one or more records returned in response to the query generated [order data transmitted to the laboratory system, col 4, lines 30-40]
- (d) rendering information associated with each of the one or more records accepted, the information rendered being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted, wherein the label is provided on the storage medium without storing it on the storage medium [photographs are printed, col 4, lines 40-48, user is provided with printer, col 5, lines 25-30, creating a slide-show, col 9, lines 45-60]

Claim 19 and 39:

Haneda discloses wherein each of the labels include human-readable part, and wherein the information associated with each of the one or more labels accepted corresponds to the human-readable part of the labels [Figs 8 and 9].

Claim 33:

Haneda discloses a database [Fig 1, 10].

Claim 34:

Haneda discloses means for synchronizing the database with a database maintained by a separate machine which created the storage medium [Fig 1, paragraph 36]

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Claim 40:

Haneda discloses wherein if the storage medium has not been assigned a unique volume label and a unique identifier then further, generating a label based on the unique label identifier and fixing the generated label to the storage medium without storing it on the storage medium [Fig 12, col 21, lines 5-20].

Claim 41:

Haneda discloses wherein if the storage medium has not been assigned a unique volume label and a unique identifier then further, generating a label based on the unique label identifier and fixing the generated label to the storage medium without storing it on the storage medium [Fig 12, col 21, lines 5-20].

Claim 42:

Haneda discloses wherein the information rendered is related to the label associated with the storage medium storing one or more files identified with the one or more records accepted such that a user or scanner can distinguish the storage medium including the label from other storage media [col 3, lines 43-50]

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 9 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda in view of US Pat No 4,864,616 issued to Pond et al (hereafter Pond), as best examiner is able to ascertain.

Claims 9 and 28:

Haneda discloses the elements of claims 1/15 as noted above but does not disclose wherein the database includes records, each record including a first field having as value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium. Pond discloses wherein the database includes records, each record including a first field having as value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium [col 3, lines 35-55]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Haneda to include wherein the database includes records, each record including a first field having as value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium as taught by Pond for the purpose of positively identifying a file in storage such that it can be quickly and accurately retrieved.

Claims 16-18 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda in view of US Pat No 5,971,279 issued to Raistrick et al (hereafter Raistrick), as best examiner is able to ascertain.

Claim 16 and 36:

Haneda discloses the elements of claims 15/35 as noted above and furthermore, Haneda discloses (e) accepting information read from the machine-readable labels [Fig 12, col 21, lines

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6-20] but does not disclose (f) if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted, then generating a first indicator, said first indicator able to be perceived by humans. Raistrick discloses (f) if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted, then generating a first indicator, said first indicator able to be perceived by humans [Fig 3]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Haneda to include (f) if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted, then generating a first indicator, said first indicator able to be perceived by humans as taught by Raistrick for the purpose of providing the user with positive indication that a bar code has been successfully read.

Claims 17 and 37:

The combination of Haneda and Raistrick discloses the elements of claims 15 and 16/35 and 36 and furthermore discloses g) if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans [Raistrick, Fig 3]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include g) if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans for the purpose of assisting the visually impaired.

Claim 18 and 38:

The combination of Haneda and Raistrick discloses the elements of claims 15-17/ 35-37 as noted above and furthermore, Raistrick discloses wherein the first indicator is a first audible sound and the second indicator is a second audible sound [Fig 3].

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda.

Claim 43:

Haneda discloses the elements of claim 1 as noted above but does not disclose updating the database based on files deleted from the storage medium. Official notice is taken that updating the database based on files deleted from the storage medium is well-known and accepted in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Haneda to include updating the database based on files deleted from the storage medium for the purpose of making searching simpler by eliminating from the database directory files which have been deleted.

Response to Arguments

Applicant's arguments filed 6/9/2006 have been fully considered but they are not persuasive.

Applicant Argues:

Applicant on pages 13-18 attempts to respond to examiner's Office action in which claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the

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specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Examiner Responds:

Examiner is not persuaded. The following is taken from paragraph 71 of the specification:

4.4.3 EXAMPLE

Show Contents

[0071] FIG. 8 is a messaging diagram that illustrates what can occur when a content listing utility is requested. As shown by communication 810, a user request for a content listing (of a storage medium) may be provided from a user interface 244 to content tracking (non-base) operation(s) 242. In response, as indicated by communication 820, the content tracking (non-base) operation(s) 242 may provide a prompt to a user, via the user interface 242, to have the user scan a storage medium label as indicated by communication 820. Assuming that the user scans the label, the scanning operation(s) 250 may then provide the media key to the content tracking (non-base) operation(s), as indicated by communication 830. A request communication 840, including this media key, may then be sent from the content tracking (non-base) operation(s) 242 to database management operation(s) 254. The database management operation(s) 254 may use this request 840 to generate a query to its database instance 256, as indicated by communication 850. A query result(s), which may include one or more records (or items), may be returned from the database instance 256 to the database management operation(s) 254 as indicated by communication 860. The database management operation(s) 254 may then provide the returned record(s) (or items(s)) to the content tracking (non-base) operation(s) 242, as indicated by communication 870. The content tracking (non-base) operation(s) 242 may then send information about the returned record(s) (or item(s)) to the user interface 244, as indicated by communication 880. This information may then be rendered to the user (e.g., in the form of a display screen).

The above procedure explains that a user scans a storage medium label in order to uniquely identify a storage volume. It is unclear how a user scans a **non-existent** (emphasis added) label such that it can be determined whether a label has been assigned for a particular storage medium. Examiner maintains that this is purely a manual operation performed by a user. A user can visually identify whether a label has been assigned to a particular storage medium.

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Certainly, the specification does not describe how “determining whether or not the storage medium has been assigned a unique volume label” can be performed by means of machine-executable instructions.

Applicant Argues:

Applicant states in the second paragraph of page 21:

The applicants respectfully, but strongly submit that the examiner is improperly ignoring features of the claimed invention which distinguishes it over the Haneda patent. Specifically, merely affixing or storing an identification code to a storage medium does not teach *determining whether or not the storage medium has been assigned a unique volume label and a unique storage medium label*.

Examiner Responds:

Examiner is not persuaded. The specification includes the following in paragraph 52:

[0052] Referring back to conditional branch point 310, recall that it is determined whether or not a storage medium is new. This may be done, for example, by comparing the unique volume label, if any, of the storage medium, with stored state information (Recall, e.g., 264 of FIG. 2.). If the storage medium is determined to be new, the method 212' continues to block 315 where a unique label and a unique volume label are determined. For example, these labels may be determined from state information 264, such as a counter that is incremented for each new storage medium for example. Then, as indicated by blocks 320 and 325, the unique volume label is written onto the storage medium, and a command to print (or otherwise generate) a unique label associated with the storage medium is generated. Referring back to FIG. 2, this command may be passed to the label generation operation 224. The user may then associate the printed unique label with the storage medium (e.g., by affixing it to a so-called "jewel-box" case or cartridge used to hold the storage medium). Alternatively, the unique label may be automatically associated with the storage medium (i.e., without (further) user intervention) in another way. As indicated by block 330, the database may be updated to reflect saved or deleted files. For example, this may be done by adding a new record (or item), or by altering an appropriate existing record (or item), when a file is saved, or by removing an appropriate record (or item) when a file is deleted. The key of the record (or item) may correspond to that used for the unique label, or the unique volume label, though this is not necessarily true. As indicated by optional block 335, a synchronization may be effected (Recall, e.g., operations 262 and 258 of FIG. 2.) if possible. The method 212' may then be left via RETURN node 360.

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The above discloses that the claim interpretation of *determining whether or not the storage medium has been assigned a unique volume label and a unique storage medium label* means that the user determines that the disk is a new disk, i.e., it has no stored data nor does it have any label identifier. Haneda teaches a new disk in Fig 10 and col 19, lines 20-60.

Examiner maintains that Haneda reads on the above claim limitation.

Applicant Argues:

Applicant states in the last paragraph of page 22 the following:

Independent claims 15 and 35, as amended, are not anticipated by the Haneda patent because the Haneda patent does not teach an act of (or means for) accepting one or more search parameters selected from a group of parameters consisting of (A) file name, (b) file size, (C) file author, and (D) file type.

Examiner Responds:

Examiner is not persuaded. Haneda discloses the following in column 54, lines 35-40:

Retrieval is facilitated if the representative image of the copy-source recording medium is used by being displayed on a menu screen that is for the purpose of searching the recording medium. The album names (file names) of a plurality of copy-source recording media are displayed on the menu screen along with the representative images of these album names. The user can observe the representative images and readily retrieve a desired copy-source recording medium in the copy-destination recording medium.

Examiner maintains that Haneda reads on “accepting one or more search parameters selected from a group of parameters consisting of (A) file name, (b) file size, (C) file author, and (D) file type.”

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Mondays through Friday between 8:00 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

8/24/2006

EP LeRoux
Primary Examiner